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OFFICE OF PETITIONS

In re Application of :
Hirotomo Ishii : DECISION ON
Application No. 09/845,349 : PETITION
Filed: May 1, 2001 :
Atty Docket No. 018775-827 :

This is a decision on the PETITION UNDER RULE 183 TO WAIVE A REQUIREMENT OF THE RULES filed January 30, 2006.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are not permitted. See 1.181(f).

Petitioner states that on November 14, 2005, they filed a Request for Continued Examination (RCE) with a Request for a Limited Suspension of Action under 37 CFR § 1.103(c) as their submission pursuant to 37 CFR § 1.114. Petitioner further states that since that filing they have learned that such a submission is improper. Petitioners submit on petition a submission and request that the Office retroactively waive the requirement of 37 CFR 1.114(a) that the submission be filed with the RCE.

37 CFR § 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on

petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

Pursuant to 37 CFR § 1.114(c), a submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

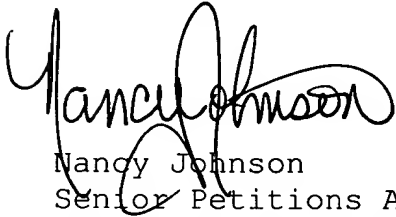
Further, as stated in MPEP 706.07(h), and as reiterated by petitioner, a request for a suspension of action, an appeal brief or a reply brief (or related papers) will not be considered a submission under 37 CFR 1.114. See 37 CFR 1.103 and 1.114(d). However, as petitioner does not acknowledge, this section further provides that a previously filed amendment after final (whether or not entered) may satisfy this submission requirement. Moreover, this section provides that arguments submitted after final rejection, which were entered by the examiner but not found persuasive, may satisfy the submission requirement if such arguments are responsive within the meaning of 37 CFR 1.111 to the Office action. Consideration of whether any submission is responsive within the meaning of 37 CFR 1.111 to the last outstanding Office action is done without factoring in the "final" status of such outstanding Office action. Thus, a reply which might not be acceptable as a reply under 37 CFR 1.113 when the application is under a final rejection may be acceptable as a reply under 37 CFR 1.111.

The record has been reviewed in light of the aforementioned rules and it has been determined that waiver of the rules is not required. Specifically, the RCE filed November 14, 2005 was filed with both a Request for Limited Suspension of Action and a request that the Office consider the amendment under 37 CFR § 1.116 previously filed September 8, 2005. As provided for in the rules, the previously filed amendment is a proper submission under 37 CFR § 1.114(c). Thus, the requested waiver of the rules is not necessary. Accordingly, the petition is dismissed.

Receipt of the petition fee is acknowledged.

Technology Center AU 2623 has been advised of this decision. The application is, thereby, returned to the TC for action following the request for suspension of action under § 1.103(c) and RCE filed November 14, 2005.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is stylized with a large, looping initial "N" and a cursive "Johnson".

Nancy Johnson
Senior Petitions Attorney
Office of Petitions